

REMARKS

Status of the Claims

At the outset, Applicants note that the Office Action Summary includes two apparent errors. First, the Summary states that the present Office Action is responsive to the communication filed on May 11, 2006. Applicants assume this is a typographical error and that the present Office Action is responsive to Applicants' most recent response, filed September 21, 2007, at least because the present Office Action addresses new claims presented in that response. Second, the Summary includes checks in the boxes for final and non-final actions, but Applicants assume that the present Office Action is non-final, at least because it is so indicated in the PAIR database.

Claims 1-19, 21-24, 27-33, 35-40, and 65-76 are presently pending in this application. Claims 5, 11, and 27-33 have been withdrawn. Consideration of claims 1-4, 6-10, 12-19, 21-24, 35-40, and 65-76 is respectfully requested.

Status of Previously Submitted Information Disclosure Statements

All of the art cited in the Information Disclosure Statement submitted by the Applicants on October 12, 2007 has not been noted as considered by the Examiner. Applicants respectfully request the Examiner to initial Cite No. AD, U.S. Published Application 20040019353-A1.

Rejections Pursuant to 35 U.S.C. § 102

Claims 1-4, 9, 10, 17-19, 35, and 65

Claims 1-4, 9, 10, 17-19, 35, and 65 are rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0015174 A1 of Null et al. ("Null"). Applicants respectfully disagree.

Independent claim 1 recites an elongate shaft having a proximal end and a distal end, the proximal end of the shaft being positioned at an angle other than 0 with respect to the distal end of the shaft. Claim 1 also recites a guide member coupled to the distal end of the elongate shaft and including first and second pathways at least partially in communication with one another and

extending therethrough in a fixed relation to one another. The distal end of the elongate shaft is offset from the first and second pathways. Claim 1 further recites at least one alignment element positioned distal of the guide member, the at least one alignment element being adapted to interact with a spinal fixation element to position the guide member with respect to the spinal fixation element such that the first and second pathways in the guide member are aligned with a pair of corresponding thru bores formed in the spinal fixation element.

Applicants thank the Examiner for clarifying the Examiner's interpretation of the word "communication" as "a means of access or communication." However, even under this interpretation of "communication," Null does not teach or suggest a guide member including first and second pathways at least partially in communication with one another and extending therethrough.

The Examiner asserts that the pathways (30, 31) in Null are at least partially in communication with one another because they are touching each other, with elements (29, 49) connecting the pathways (30, 31). However, the components (30, 31) that the Examiner identifies as pathways are actually guide members (30, 31), as clearly identified, for example, in Null's FIG. 2 and paragraph [0027]. The guide members (30, 31) each have pathways or passages that extend therethrough (*see, e.g.*, paragraph [0027]), but the elements (29, 49) connect the *guide members* (30, 31), not the *passages* that extend through the guide members (30, 31). The guide members (30, 31) cannot be the first and second pathways of claim 1, with the guide portion (12) forming the claimed guide member as the Examiner apparently asserts, because the guide members (30, 31) are not surrounded by anything and hence do not and cannot extend through anything. Thus, even if the outer surfaces of the guide members (30, 31) could be considered to be in communication with one another via the elements (29, 49), the *passages* extending through the guide members (30, 31) are not touching each other and do not have any means of access or communication with each other. Rather, the passages are separate and distinct from one another. Indeed, the elements (29, 49) *prevent* means of access or communication between the passages of the guide members (30, 31) because the elements (29, 49) are solid members separating at a distance the guide members (30, 31) and their passages.

In contrast, the pathways in Applicants' claim 1 do have means of access or communication with each other because, for example, as clearly shown in FIGS. 5B and 5D, a first cut-out portion (128) provides means of access or communication between first and second pathways (520, 522). Such means of access or communication can be advantageous, for example, by "provid[ing] the surgeon with improved visual access to a spinal fixation element positioned in relation to the guide member 518, as well as to tools and devices used in connection with the guide device 510." (Paragraph [0048].) The elements (29, 49) in Null *prevent* such visual access because they are solid members separating the guide members (30, 31) and their passages.

Accordingly, independent claim 1, as well as claims 2-4, 9, 10, 17-19 which depend therefrom, distinguish over Null and represent allowable subject matter. Independent claims 35 and 65 also recite pathways being at least partially in communication with each other and extending through a guide member, so claims 35 and 65 distinguish over Null for at least the reasons discussed for claim 1.

Claims 1, 35, 36-40, 65, 73, and 74

Claims 1, 35, 36-40, 65, 73, and 74 are rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0092947 A1 of Foley ("Foley"). Applicants respectfully disagree.

Foley does not teach or suggest a guide member including first and second pathways at least partially in communication with one another and extending therethrough as is recited in independent claims 1, 35, 65, and 74. The analysis above regarding Null similarly applies to Foley. The components (26, 66) that the Examiner identifies as pathways in Foley are actually guide members (26, 66), as clearly identified, for example, in Foley's FIG. 2 and paragraph [0025]. While the guide members (26, 66) are connected to one another by a connecting member (41), as can clearly be seen in FIGS. 2-5, *passages* (30, 70) extending through the guide members (26, 66) are separate and distinct from one another. The guide members (26, 66) cannot be the first and second pathways of claim 1, with the distal guide portion (25) forming the claimed guide member as the Examiner apparently asserts, because the guide members (26, 66) are not surrounded by anything and hence

do not and cannot extend through anything. Thus, even if the outer surfaces of the guide members (26, 66) could be considered to be in communication with one another via the connecting member (41), the *passages* (30, 70) extending through the guide members (26, 66) are not touching each other and do not have any means of access or communication with each other. Rather, the passages (30, 70) are separate and distinct from one another. Indeed, the connecting member (41) *prevents* means of access or communication between the passages (30, 70) of the guide members (26, 66) because the connecting member (41) is a solid member separating at a distance the guide members (26, 66) and their passages (30, 70).

Accordingly, independent claims 1, 35, 65, and 74, as well as claims 36-40 which depend from claim 35, distinguish over Foley and represent allowable subject matter.

Claim 73

Independent claim 73 recites an elongate shaft having proximal and distal ends. The proximal end of the shaft is positioned at an angle other than 0 with respect to the distal end of the shaft. Claim 73 further recites a guide member coupled to the distal end of the elongate shaft and adapted to be juxtaposed on a spinal fixation element having first and second thru bores formed within a single lumen. The guide member includes a first substantially C-shaped lateral sidewall for guiding implants, tools, and devices through the first thru bore in the spinal fixation element, and a second, opposed substantially C-shaped lateral sidewall for guiding implants, tools, and devices through the second thru bore in the spinal fixation element.

At the outset, Applicants note that the Examiner identically repeats the rejection from the Office Action dated July 5, 2007 and does not appear to address Applicants' amendment to claim 73 or Applicants' related arguments presented in the response filed September 21, 2007. Foley does not teach or suggest a guide member having first and second thru bores formed within a single lumen and C-shaped sidewalls for guiding implants, tools, and devices through the thru bores. There is no single lumen in Foley, and, as explained above, the passages (30, 70) are separate and distinct. Accordingly, independent claim 73 distinguishes over Foley and represents allowable subject matter.

Claims 6-8, 12-16, 21-24, 66-72, 75, and 76

Applicants thank the Examiner for indicating that claims 6-8, 12-16, 21-24 and 66-72 would be allowable if rewritten in independent form. At least because claims 6-8, 12-16, 21-24 and 66-72 depend from allowable base claims as discussed above, Applicants respectfully request allowance of dependent claims 6-8, 12-16, 21-24 and 66-72. Applicants also respectfully request continued allowance of independent claims 75-76.

Conclusion

Applicants submit that all claims are in condition for allowance for at least the reasons discussed above, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Dated: February 6, 2008

Respectfully submitted,

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